

REMARKS

The Examiner is thanked for his careful and very thorough Office Action.

Claims 1-12 have been rejected.

Please note that the above amendments to claims 1, 4, 5, and 8 are intended to be purely formal amendments and are believed not to change the scope of these claims.

New dependent claims 19-24 have been added by the above amendments. The claims recite, "wherein said mechanism produces an original work of art", and "wherein said mechanism produces a work of art". The support for these claims can be found, for example, in paragraph [0006] beginning on line 2 of page 2, paragraph [0022] beginning on line 27 of page 4, and paragraph [0023] beginning on line 15 of page 5 of the present application.

Also, the Examiner states that claims 1-12 were elected without traverse. Applicants would like to correct this by noting that claims 1-12 were provisionally elected with traverse by the preliminary amendment of 07 April 2005. Accordingly, the withdrawal of non-elected claims 13-18 is subject to reinstatement in the event the requirement for restriction is withdrawn or overruled as per 37 C.F.R. §1.142(b).

Rejections under 35 USC 112

Claims 1-12 stand rejected under 35 USC Section 112, second paragraph, as being indefinite.

The Examiner has suggested that the phrase "or similar substances" renders claims 1-12 indefinite. However, Applicants respectfully disagree with the Examiner. Section 2173.04 of the MPEP states:

2173.04 Breadth Is Not Indefiniteness

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Applicants respectfully submit that the scope of the subject matter embraced by this phrase is not indefinite in light of the specification. It clear that the phrase "or similar substances" refers to substances that can be used to create textured paintings. For example, the abstract states, **"A mechanism and method for depositing oil paints, acrylics, or other textural paints..."** Applicant has no way of knowing every possible substance that may be used to create textured paints. Applicants do, however, welcome any suggestions from the Examiner for a possible amendment without reducing the claim scope.

Art Rejections

The art rejections are all respectfully traversed.

Rejections Under 35 USC 102(b)

- Claims 1, 3, 4, 6, 8 and 12 stand rejected under 35 USC Section 102(b) as being anticipated by *Ishida et al.* (U.S. Patent No. 5,932,012).

Ishida et al. does not teach or suggest each element of claim 1. Specifically, claim 1 recites, **"An automated mechanism to deposit oil paint or similar substances onto a canvas."**

The Examiner has suggested that *Ishida et al.* teaches such a mechanism. However, Applicant respectfully disagrees with this suggestion.

Firstly, *Ishida et al.* discloses a means for dispensing sealing paste not oil paint or similar substances.

Secondly, *Ishida et al.* does not disclose depositing anything onto a canvas. It merely recites a substrate, an example of which is a *"liquid crystal sealing substrate"* (col. 1, line 44). In contrast, Merriam-Webster Online Dictionary defines a canvas, for example, as **"a piece of cloth backed or framed as a surface for a painting"**. Therefore, a canvas is not disclosed by *Ishida et al.*

According to the Federal Circuit:

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art.

Motorola, Inc., v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 1.

Claim 4 also recites elements not taught or suggested by *Ishida et al.* Specifically, claim 4 recites, **"An automated mechanism to deposit and redistribute oil paint or a similar substance onto a canvas."**

As established earlier, *Ishida et al.* does not disclose an automated mechanism for depositing oil paint onto a canvas, much less a mechanism to redistribute the paint.

Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 4.

Claim 8 also recites elements not taught or suggested by *Ishida et al.* Specifically, claim 8 recites:

**An automated mechanism to deposit oil paint or similar substances onto a canvas comprising:
an attachment mechanism through which a canvas suitable for painting is held in place;
a deposition mechanism for depositing a selectable amount of paint through a well defined opening onto a canvas held by said attachment mechanism;
a motion control mechanism, attached to said deposition mechanism to move said deposition mechanism to a desired position with respect to the canvas; and
a control system which receives external data describing an amount of a given paint which is to be deposited at a pre-determined position onto the canvas and which controls said motion control system and paint deposition mechanism.**

As established earlier, *Ishida et al.* does not disclose elements such as “a canvas suitable for painting”, “a selectable amount of paint”, “data describing an amount of a given paint”, and “paint deposition mechanism”.

Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 8.

Finally, dependent claims 3, 6, and 12, which depend directly from independent claims 1, 4, and 8 and incorporate all the limitations thereof, also include additional limitations that are not shown or suggested by *Ishida et al.*

For example, claims 3 and 6 recite, “...a syringe to deposit said paint.”

As established earlier, *Ishida et al.* deposits sealing paste not paint.

Thus, for this reason, and for the reasons discussed above, Applicant respectfully requests withdrawal of this rejection.

- Claims 1, 2, 4, 5, and 7 stand rejected under 35 USC Section 102(b) as being anticipated by *McNeely* (U.S. Patent No. 3,321,331).

McNeely does not teach or suggest each element of claim 1. Specifically, claim 1 recites, “An automated mechanism to deposit oil paint or similar substances onto a canvas.”

The Examiner has suggested that *McNeely* teaches such a mechanism. However, Applicant respectfully disagrees with this suggestion.

Firstly, *McNeely* discloses a means for dispensing a lane dressing compound. It does not dispense paint or any similar substance.

Secondly, *McNeely* does not disclose depositing anything onto a canvas. It deposits lane dressing compound onto a bowling lane, not a canvas. Just as the “liquid crystal sealing substrate” of *Ishida et al.* is not a canvas, the bowling lane of *McNeely* is not a canvas.

Again, according to the Federal Circuit:

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art.

Motorola, Inc., v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 1.

Claim 4 also recites elements not taught or suggested by *McNeely*. Specifically, claim 4 recites, **"An automated mechanism to deposit and redistribute oil paint or a similar substance onto a canvas."**

As established above, *McNeely* relates to depositing a lane dressing compound onto a bowling lane. It does not disclose an automated mechanism for depositing and redistributing oil paint onto a canvas.

Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 4.

Finally, dependent claims 2, 5, and 7, which depend directly from independent claims 1 and 4 and incorporate all the limitations thereof, also include additional limitations that are not shown or suggested by *McNeely*.

For example, claims 2 and 5 both recite, **"... a paint deposition mechanism which is capable of moving in three dimensions."**

As established earlier, the deposition mechanism of *McNeely* deposits a lane dressing compound, not paint. Also, the deposition mechanism of *McNeely* is not capable of moving in three dimensions. As stated in col. 1, lines 55-56 of *McNeely*, "...the lane-maintenance machine comprises a carriage movable longitudinally along the lane ..."

Thus, for this reason, and for the reasons discussed above, Applicant respectfully requests withdrawal of this rejection.

- Claims 1-6, 8 and 12 stand rejected under 35 USC Section 102(b) as being anticipated by *Penn et al.* (U.S. Patent No. 5,594,652).

Although the heading of this rejection states that claims 1-6, 8 and 12 are rejected, the Examiner has only addressed claims 1-6 in his rejection. Therefore, Applicants can only respond to the rejection of claims 1-6, and claims 8 and 12 are deemed not be anticipated by *Penn et al.*

Penn et al. does not teach or suggest each element of claim 1. Specifically, claim 1 recites, “An automated mechanism to deposit oil paint or similar substances onto a canvas.”

The Examiner has suggested that *Penn et al.* teaches such a mechanism. However, Applicant respectfully disagrees with this suggestion.

Penn et al. relates to the manufacturing of three-dimensional objects, not canvas paintings. *Penn et al.* utilizes a printhead to dispense layers of a eutectic material onto a target substrate. These layers are stacked to form a three-dimensional object. *Penn et al.* does not utilize a canvas.

Again, according to the Federal Circuit:

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art.

Motorola, Inc., v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 1.

Claim 4 also recites elements not taught or suggested by *McNeely*. Specifically, claim 4 recites, “An automated mechanism to deposit and redistribute oil paint or a similar substance onto a canvas.”

As established above, *Penn et al.* uses a printhead to stack layers of a eutectic material to form a three-dimensional object. It does not deposit paint onto or redistribute paint on a canvas.

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Accordingly, a prima facie case of anticipation has not been established by the Examiner with regard to claim 4.

Finally, dependent claims 2, 3, 5, and 6 depend directly from independent claims 1 and 4 and incorporate all the limitations thereof.

Thus, for this reason, and for the reasons discussed above, Applicant respectfully requests withdrawal of this rejection.

Rejections Under 35 USC 103(a)

- Claim 11 stands rejected under 35 USC Section 103(a) as being unpatentable over *Ishida et al.* (U.S. Patent No. 5,932,012) in view of *Barlage, III et al.* (U.S. Patent No. 5,859,775).

Dependent claim 11 depends directly from independent claim 8 and incorporates all the limitations thereof.

Thus, for the reasons discussed above, Applicant respectfully requests withdrawal of this rejection.

- Claims 9-10 stand rejected under 35 USC Section 103(a) as being unpatentable over *Ishida et al.* (U.S. Patent No. 5,932,012) in view of *McNeely* (U.S. Patent No. 3,321,331).

Dependent claims 9-10, which depend directly or indirectly from independent claim 8 and incorporate all the limitations thereof, also include additional limitations that are not shown or suggested by the asserted combination.

For example, claim 9 recites, "... a painting implement attached to said motion control system to be used to redistribute paint on the canvas."

As stated above, neither of the references, singly or in any motivated combination thereof, discloses or suggests redistributing paint on a canvas.

Thus, for the reasons discussed above, Applicant respectfully requests withdrawal of this rejection.

Conclusion

All grounds of rejection and/or objection are traversed or accommodated, and favorable reconsideration and allowance are respectfully requested. The Examiner is requested to telephone the undersigned attorney or Patrick C. R. Holmes for an interview to resolve any remaining issues.

Respectfully submitted,

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Date



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